UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,971	11/14/2000	Ivo Glynne Gut	147-201P	8231

2292 7590 03/03/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER	
LU, FRANK WEI MIN	
ART UNIT	**PAPER NUMBER**
1634	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/555,971	Applicant(s) GUT ET AL.	
	Examiner Frank W Lu	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached office action.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

DETAILED ACTION

ADVISORY ACTION

1. Applicant arguments filed on January 27, 2005 have been fully considered and entered.

Response to Arguments

I. In page 6, first paragraph of applicant's remarks, applicant argues that "[I]n their response filed on August 5, 2004, Applicant specifically amended the description on page 14 to delete the embedded hyperlinks. Reconsideration and removal of the objection is respectfully requested".

This argument has been fully considered and the examiner agrees to withdraw this objection.

II. In page 6, second paragraph of applicant's remarks, applicant argues that the amendment on claim 1 has overcome the rejection under 35 U.S.C 112, second paragraph.

This argument has been fully considered and the examiner agrees to withdraw this rejection.

III. In page 6, second paragraph bridging to page 8, second paragraph of applicant's remarks, applicant argues that: (1) "[N]ess does not analyze the entire 'probe' or nucleic acid fragment of the probe but rather merely isolate the tag and subjects the tag to analysis. Ness, therefore, clearly related to the detection and analysis of tags as opposed to probes. Unlikely the present invention, Ness certainly does not teach or disclose the exclusion or elimination of the step of cleaving the tags from the probes, nor of the complete omission of the tag. From the Examiner's comments, it appears that the Examiner has equated the 'tag' of Ness with Applicant's claimed probes. As discussed above, this clearly not the case. Moreover, it appears that the Examiner

recognizes that the Ness method is just 'one of [the] ways to analyze nucleic acid probes' and as such, anticipates the present claims"; and (2) "[I]n the present instance, the claimed method relies on the analysis of the nucleic acid molecules (ie., the probe themselves) by means of electrospray mass spectrometry. As discuss above, Ness merely analyzes the chemical tags attached to the nucleic acid fragment of its probes using electrospray mass spectrometry. While both methods may be used to draw conclusions or to determine the sequence of the target nucleic acid molecule, they are not the same. As such, Ness cannot be held to anticipate the present claims and the Examiner's attempts to expand the teachings of Ness to do so is improper".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. First, the Examiner has not equated the 'tag' of Ness with Applicant's claimed probes as suggested by applicant. In fact, in the rejection, tagged nucleic acid molecules with different sizes taught by Ness *et al.,* are considered as a set of probes of different nucleotide sequences as recited in claim 1. Second, since the claims do not require direct analysis of the probes that are detached from step (c) by means of electrospray mass spectrometry and Ness *et al.,* teach cleaving the tag from the separated tagged nucleic acid molecules and detecting the tag by non-fluorescent spectrometry or potentiometry (see columns 2-4 and 54) such as electrospray ionization mass spectrometry (see column 3, last paragraph), Ness *et al.,* disclose indirect analysis of the probes that are detached from step (c) by means of electrospray mass spectrometry as recited in step (d) of claims 1, 19, and 20.

IV. In page 8, last paragraph bridging to page 9, first paragraph of applicant's remarks, applicant argues that "[A]pplicant submits that the secondary prior art references cited by the Examiner fail to disclose or suggest the element missing from Ness, and, such similarly

fail, either single or in combination, to teach the claimed invention. As such, the obviousness rejections must fall".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection because, as shown in ***Response to Arguments*** (III), Ness *et al.*, teach all limitations recited in claims 1-3, 6-10, 14, 16, 17, 19, and 20 and the secondary references used in the obviousness rejections are used to reject dependent claims 4, 5, 15, and 18.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)272-0745.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
February 24, 2005

KENNETH R. HORLICK, PH.D
PRIMARY EXAMINER

3/1/05